

REMARKS

This paper is submitted in response to the Office Action mailed October 6, 2004. Following this amendment, claims 1-34, and 36-53 are pending. Claim 35 has been cancelled because it is a duplicate of claim 34.

The Examiner has issued a restriction requirement and requires selection of one of two groups of claims for prosecution in this application. The Examiner has placed the pending claims into the following groups:

Group I: claims 1-33, and 36-53, drawn to a synthetic nucleic acid and vector; and

Group II: claims 34-35, drawn to a pharmaceutical composition.

The Examiner has alleged that the subject matter of groups I and II are distinct and unrelated. According to the Examiner, inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effects. The Examiner alleges that the different invention of the groups have different modes of operations leading to different effects. The Examiner alleges that the nucleic acid and vector of group I can be used in nucleic acid cloning procedures, whereas the invention of Group II is drawn to a pharmaceutical composition comprising a physiologically acceptable carrier which can be used in methods of treatment. The searches of the different inventions are not co-extensive, because the nucleic acid of group I does not require the components of the composition of group II to operate. The Examiner alleges that different invention requires different fields of search which would constitute an undue burden to the Examiner if not restricted. The Examiner further indicates that the inventions are allegedly distinct, the search for one group is allegedly not required for the other group, the subject matter of each allegedly acquires a separate status due to their recognized divergent subject matter, and

that the groups are placed into different classification groups. The Examiner, therefore, concludes that restriction for examination purposes is proper. Applicants respectfully traverse.

There are two criteria for a proper requirement for restriction between patentably distinct inventions (see MPEP § 803). First of all, the inventions must be independent or distinct as claimed (see MPEP § 806.05 - § 806.05(i)). Secondly, there must be a serious burden on the Examiner if restriction is required (see MPEP § 808.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). MPEP § 803 also states that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner *must* examine it on the merits, even though it contains claims to distinct or independent inventions.” (Emphasis supplied).

Applicants respectfully submit that the subject matter of the two Groups is not distinct. The subject matter of the groups I and II is related as subcombination and combination, respectively. Where the relationship between the claims is such that the separately claimed subcombination constitutes the essential distinguishing feature of the combination as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility (See MPEP § 806.05(c)(II)). Since the modified nucleic acid of group I (subcombination) is the essential distinguishing feature of the composition of group II (combination), the groups are not distinct.

Applicants further submit that the claims are connected by a single, searchable unifying relationship. The modified synthetic nucleic acid does not have a separate status forming a separate subject for inventive effort from the composition comprising the modified synthetic nucleic acid. A search of group II would not require a different field of research from a search of group I. Therefore, applicants assert that the Examiner would not be seriously burdened by searching and examining all of the claims of these two groups in a single application. For the foregoing reasons, Applicants request withdrawal of the restriction requirement.

Should the Examiner not find the traversal persuasive, in order to be fully responsive, Applicants elect the subject matter of group I, consisting of claims 1-33, and 36-53, with traverse and without prejudice to the prosecution of the subject matter of non-elected claims in other patent applications.

Applicants do not believe that any fee is required in connection with the submission of this paper. However, should any fee be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Rochelle K. Seide". The signature is written in dark ink and is positioned above the printed name.

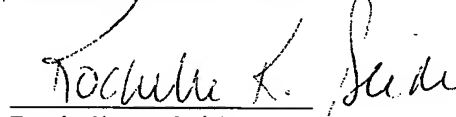
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